

REMARKS

This Response is made to the final Office Action of December 22, 2005. Claims 35-74 are pending in this application. Applicants respectfully request reconsideration of all the pending claims in view of the remarks presented below.

Claims 35-40, 42-50, 52-74 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,171,327 to Daniel et al. ("the Daniel patent"). Applicants submit that the Examiner has misinterpreted the Daniel patent, has relied on an embodiment (shown in Fig. 19) in the Daniel patent which lacks even the basic structure recited in the present claims, and may have misconstrued the claims by failing to appreciate the particular function and the interrelationship of elements recited in the present claims. For at least these reasons, addressed in greater detail below, Applicants believe that the Daniel patent should be withdrawn as an anticipatory reference.

Applicants submit that the Daniel patent fails to disclose a number of the elements, along with the structural relationships between these elements, as recited in the pending claims. First, the presently claimed inventions defined by claims 35, 45, 54 and 68 recite a system for recovering an embolic protection device which includes an inner catheter with a distal portion having a length of flexible tubing of sufficient length which allows the distal end of the recovery sheath to track thereover and reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel. This length of tubing of the inner catheter extends distally beyond the distal end of the recovery sheath when being advanced over the guide wire. However, such a structure is simply not shown in the Daniel patent. Applicants note that the inner catheter, which the Examiner has identified as component (172) in FIG. 20 or component (372) in FIG. 23 of the Daniel patent, includes only a small tapered portion (180) which barely extends beyond the recovery sheath (150) during usage. Applicants strongly disagree with the Examiner's position that this distal tapered portion (180) somehow constitutes a "length of tubing" which extends beyond the distal end of the recovery sheath. Moreover, this distal tapered portion (180) is simply the end portion of a large

insert or portion (176) which is housed within the recovery sheath and is designed to provide a relatively soft and atraumatic tip to the composite catheter. This portion (176) remains within the lumen or housing of the recovery sheath during usage with only a small portion of the tapered portion (180) extending beyond the end of the recovery sheath.

The Examiner's position regarding the identity of the location of the distal portion of the inner catheter can be found at page 6, lines 1-7 of the Office Action which reads as follows:

The distal portion (172, 180) is part of the inner catheter, which is a flexible tube. Examiner does not consider only the tip of the inner catheter to be the distal portion of the inner catheter. The "distal portion" can be any length of the inner catheter distal to the most proximal point. Therefore, the Daniels device includes a length of the inner catheter that is at least as long as the filter. The "recovery sheath does "move over" the entire inner catheter, so this argument is not found to be persuasive.

While the Examiner may be correct in stating that the distal portion (172, 180) is part of the inner catheter, the only portion of the inner catheter which arguably could be construed as a flexible tube is the portion of the inner catheter which extends proximally, not distally, to this portion (176). Again, this portion (176) is designed to fill in the lumen of the housing (152) and remains within the housing during use, with only the small tapered portion (180) extending distally out of the housing. In this manner, a tip is created to prevent the housing from scraping the sides of the body vessel as the retrieval catheter is advanced within the patient. However, this portion (176) and tapered portion (180) do not constitute a length of flexible tubing as recited in the claims.

If this distal tip portion 180 is indeed construed to be a "length of tubing," as the Examiner contends, then it still must be capable of allowing the distal end of the recovery sheath to track thereover to reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel. However, the tapered tip portion 180 doesn't even make contact with the recovery sheath, no less

allowing the recovery sheath to track thereover to reduce the chances of the recovery sheath straightening a curved portion of the body vessel.

The Examiner's above-stated position as to what constitutes the distal portion of the inner member is further incorrect. In the claims, the distal portion cannot be "any length of the inner catheter distal to the most proximal point" as stated by the Examiner. Rather, the present claims recite that the distal portion of the inner catheter extends distally beyond the distal end of the recovery sheath when the inner catheter and recovery sheath are being advanced over the guide wire. The only portion of the inner catheter of the Daniels device which extends beyond the recovery sheath is this small tapered tip 180. Therefore, the Examiner's position that the "distal portion" can be any length of the inner catheter distal to the most proximal point simply misconstrues the particular structure recited in the present claims. For this same reason, the distal portion of the Daniel device cannot be at least as long as the filter, as stated by the Examiner at page 6 of the Office Action, but at best only as long as the length of the tapered portion (180).

Applicants further believe that there are other examples where the Examiner may have misconstrued the present claims which may have lead the Examiner to incorrectly apply the Daniel patent to the claims. For example, at page 5, lines 11-13 of the Office Action, the Examiner states as follows:

Claims 35 recites "inner catheter has sufficient length to allow the distal end of the recovery sheath to track thereover to reduce the possibility ..."

However, claims 35 states that it is the distal portion (i.e., the length of tubing extending beyond the distal end of the recovery sheath) of the inner catheter which has the sufficient length to allow the distal end of the recovery sheath to track thereover to reduce the possibility. ... Therefore, after reading this statement by the Examiner, Applicants respectfully submit that the Examiner may have misconstrued the claim language and improperly applied the Daniel patent based upon improper claim construction.

The Examiner also has relied upon an embodiment in the Daniel patent to support the position that the recovery sheath tracks over the inner catheter. However, as can be clearly seen in the drawings, this embodiment lacks even the basic inner catheter recited in the claims. At page 2, lines 16-18, the Examiner states as follows:

The recovery sheath (151) tracks over the distal portion on the inner catheter to retrieve the filter, as shown in Figure 19.

However, this embodiment of the Daniel patent doesn't even have an inner catheter, no less an inner catheter with a distal portion having a length of flexible tubing of sufficient length which allows the distal end of the recovery sheath to track thereover and reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel. The embodiment of Figures 17-19 simply shows a tapered insert 58 attached to a guide wire and movable within the housing 52 of the recovery catheter. There is no inner catheter. For at least this reason, Applicants submit that the Examiner has failed to meet the Examiner's burden of citing a reference which includes a recovery sheath which tracks over the distal portion on the inner catheter as recited in the present claims.

For at least all of the reasons stated above, Applicants believe that the Daniel patent fails to disclose the structure recited in the pending claims. Accordingly, Applicants again respectfully request the Examiner to withdraw the Daniel patent as an anticipatory reference.

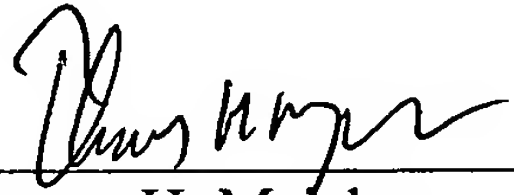
Claims 41 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Daniel patent in view of U.S. Patent No. 5,201,757 to Heyn et al. ("the Heyn patent"). Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Daniel patent itself. In view of the remarks addressed above with respect to the presently claimed invention defined by claims 35 and 45, it is believed that the particular combination of the Daniel patent with the Heyn patent, or the Daniel patent itself, fails to achieve the claimed structure. Applicants respectfully request the Examiner to withdraw the obviousness rejections against claims 38, 41 and 51.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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